

Attorney Docket No.: J2071(C)
Serial No.: 10/559,115
Filed: June 8, 2006
Confirmation No.: 1305

REMARKS

Applicants wish to thank the Examiner for again reviewing the present patent application. No new issues requiring further searching are presented herewith.

I Rejection Under 35 USC §112, Second Paragraph

The Examiner had rejected claim 6 under 35 USC §112, second paragraph, and alleged that the same was indefinite for failing to particularly point out distinctly claim the subject matter which Applicants regard as the invention.

In view of the aforementioned Office Action mailed October 21, 2009, it is apparent that the second paragraph rejection has been withdrawn and rendered moot. Applicants acknowledge and appreciate that the rejection has been withdrawn.

II. Rejection Under 35 USC §103

The Examiner has now finally rejected claims 1-9 under 35 USC §103 as being unpatentable over Patent Abstracts of Japan, Publication No. JP 2003-055184 (hereinafter, '184) in view of Deckner et al., U.S. Patent No. 5,968,528 (hereinafter, '528). The Examiner mentions that the rejection is maintained for the reasons of record. The Examiner further notes, in summary, that the '184 reference teaches a skin care composition with bleaching action wherein the composition has an extract from the plant *Symplocos recemosa*. The Examiner maintains that the extract may be extracted from

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bark or other parts of a plant and that extracts from *Symplocos* can have excellent oxygen scavenging activity as well as collagenase and tyrosinase inhibitory actions. The Examiner continues and maintains that the '184 reference describes a skin care composition that yields excellent aging prevention actions.

Inherently, the Examiner notes that the '184 reference does not, even remotely, describe the use of Vitamin B3 and extracts from the plants of the genus *Rubia*, particularly *Rubia cordifolia*. Nevertheless, the Examiner relies on the '528 reference for curing the deficiencies of the primary reference, and mentions that the same describes compositions with Vitamin B3 and extracts from plants of genus *Rubia*.

In view of the above, the Examiner believes that it would have been obvious to one of ordinary skill in the art at the time the invention was made to combine the instantly claimed ingredients mentioned in the references since the Examiner believes the idea for combining the same flows logically. Thus, the Examiner, again, continues to believe that the rejection made under 35 USC §103 is warranted.

Notwithstanding the Examiner's apparent position to the contrary, it is the Applicants' position that the presently claimed invention is patentably distinguishable from the above-described for at least the following reasons.

Again, the present invention, as presented in independent claim 1, is directed to a cosmetic skin lightening composition comprising 0.1 to 50% by wt. of extracts of plants from the genera *Symplocos* and *Rubia*, the extract of *Symplocos* being selected from *Symplocos recemosa*, *Symplocos paniculata*, *Symplocos cochinchinesis* or mixtures

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thereof and the extract of *Rubia* being *Rubia cordifolia* wherein the extracts are primary skin lightening agents within the composition.

The invention of claim 1 is further defined by the dependent claims, which claim, among other things, that sunscreen may be employed and the amount of sunscreen, that secondary skin lightening agents may be employed, specific extract that may be employed, the type of sunscreen that may be employed, the type of secondary skin lightening agent that may be employed, and the additional types of extracts that may be used. Previously presented claim 9 further characterizes the composition of claim 1 in that the secondary skin lightening agent that may be employed is niacin, niacinamide, or niacinamide ascorbate.

In contrast and as already made of record, the '184 reference merely discloses that an extract from the plant of the *genus Symplocos* may be used in a skin care preparation that exhibits anti-aging benefits and bleaching actions. The reference fails in every way to specifically describe all of the specific *Symplocos* extracts set forth in the claimed invention. Moreover, the reference is deficient in that it fails in every way to describe the extract of *Rubia* used in conjunction with *Symplocos* extract.

In an attempt to cure the vast deficiencies of the primary reference, namely the '184 reference, the Examiner, again, relies on the '528 reference which merely mentions that extract in the *genus Rubia*, particularly *Rubia cordifolia*, can be used as a natural anti-inflammatory agent. There is no teaching whatsoever in the '528 reference that even remotely suggests an extract of *Rubia* will yield excellent skin lightening benefits when used in conjunction with extract of *Symplocos*. There is also no teaching

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whatsoever that even remotely suggests that such extracts in combination will yield a stable composition. Moreover, there is no teaching whatsoever in the references relied on by the Examiner that even remotely suggest the unexpected synergistic benefits the inventors observed when using a mixture of the aforementioned extracts. Applicants, again, wish to direct the Examiner's attention to, for example, Table 1 of the specification as originally filed wherein it is shown that a combination of *Rubia* and *Symplocos* extracts show a synergistic reduction in the amount of melanin formed in a culture of melanocytes which would result in skin lightening. Applicants wish to particularly point out to the Examiner that the data in Table 1 shows *Rubia* alone had no influence on the amount of melanin formed. The results in this invention would not, therefore, have been predictable to the skilled artisan. Moreover, the data in Table 2 of the specification clearly shows that *Rubia* and *Symplocos* extracts alone and in combination with one another decrease the uptake of melanin by keratinocytes as proven via testing with HaCaT keratinocytes in culture.

In view of the above, Applicants respectfully submit that a *prima facie* case of obviousness has not been established and that all claims of record are in condition for allowance.

Turning to the Examiner's response to the arguments made under 37 CFR §1.111, the Examiner mentions that the fact that Applicants recognize another advantage which would flow naturally from the art is not a basis for patentability. Further, the Examiner dismisses any claim to unexpected results/synergy since the Examiner believes it is unclear if the claimed range is for one or both extracts.

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Notwithstanding the above, Applicants respectfully disagree. Firstly, the Examiner has not previously raised any issues regarding the range of "0.1-50%" being indefinite. The assertion cannot be made now, and the claim covers a composition with 0.1 to 50% by weight total extract.

It is well settled that an obviousness rejection cannot be sustained via a mere conclusory statement. The results the present inventors obtained and consistent with the claimed invention are not predictable and not the result of a simple substitution. There is no reason provided by the Examiner as to why the extracts in the disclosures should be combined when one extract is relied on for whitening enhancement and extracts from genus *Rubia* are taught for use as an anti-inflammatory agent. Furthermore, Applicants, again, have shown that *Rubia* alone did not influence the amount of melanin formed. In the present case, therefore, the person of ordinary skill in the art would not have reasonably looked to the secondary ('528 reference) to enhance lightening with an extract of *Rubia*. Finally, Applicants unexpected/synergistic results cannot be ignored and this invention would not have been predicted at the time of making.

Reconsideration and favorable action are earnestly solicited.

Applicants, again, welcome comments from the Examiner so that prosecution of the instant application may be expedited. A telephonic call is welcome so that the extreme expense of an Appeal may be avoided.

The present claims are ready for Appeal.

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In the event the Examiner has any questions concerning the present patent application, the Examiner is kindly invited to contact the undersigned counsel at her earliest convenience.

Respectfully submitted,

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